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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,029	09/18/2003	Merwin H. Alferness	ROC920030085US1	9131
30206 7590 05/14/2010 IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER NGUYEN, TANH Q	
			ART UNIT 2182	PAPER NUMBER
			NOTIFICATION DATE 05/14/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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MAILED

MAY 13 2010

In re Application of: ALFERNESS et al.

Serial No.: 10/667,029

Filed: September 18, 2003

Docket: ROC920030085US1

Title: METHODS AND APPARATUS FOR
ALLOCATING BANDWIDTH FOR A
NETWORK PROCESSOR

Technology Center 2100

DECISION ON PETITION
under 37 C.F.R. § 1.181

This paper provides the decision on the petition filed March 1, 2010, under 37 C.F.R. § 1.181 and M.P.E.P. § 706.07 to withdraw the Notification of Non-Compliant Appeal Brief, mailed December 31, 2009.

The Petition is **GRANTED**.

Applicable Prosecution History

January 16, 2007	RCE filed with amendments to the claims.
March 6, 2007	Non-Final action mailed: introduced rejection under 35 USC 112 first paragraph for not providing enablement for the added limitation <i>"determining an amount of memory bandwidth of a network processor allocated among a plurality of data types used to transmit data through a plurality of active ports"</i> , hence requiring one amount of memory bandwidth for all active ports and/or data types.Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "dynamically activating a port for transmitting data of the data type" [step 314, FIG. 3], does not reasonably provide enablement for <i>"dynamically adjusting the amount of memory bandwidth allocated to at least one of the plurality of data types based on the determinations"</i> .
June 6, 2007	Response with minor amendments.

August 17, 2007 Final Rejection mailed. Maintained the 112-1 rejections, "because the specification, while being enabling for "determining an amount of bandwidth allocated to each of active port for each data type" [step 304, FIG. 3], hence requiring one amount of memory bandwidth being allocated for an active port and/or data type, and another amount of memory bandwidth being allocated for another active port and/or data type; and while enabling for "determining a difference between a maximum amount of bandwidth that may be used by the data types and the total amount of bandwidth currently used by the data types" [step 308, FIG. 3] - does not reasonably provide enablement for the limitation "determining an amount of memory bandwidth of a network processor allocated among a plurality of data types used to transmitt data through a plurality of active ports", hence requiring one amount of memory bandwidth for all active ports and/or data types".

October 17, 2007 Response. No amendment.

October 29, 2007 Advisory Action mailed.

December 17, 2007 RCE filed with remarks and amendment. The amendment changed "allocated" to "used" in claim 1, changing claim 1 to recite as follows: "determining an amount of memory bandwidth of a network processor ~~allocated among~~ used by a plurality of data types used to transmit data through a plurality of active ports; determining an amount of memory bandwidth of the network processor used by each of the plurality of data types; and dynamically adjusting an amount of memory bandwidth allocated to at least one of the plurality of data types based on the determinations." To overcome the rejections under 35 USC 112 first paragraph, and points to pages 6, 7 and 10 for support.

March 20, 2008 The non-final office action mailed on March 20, 2008, dropped the rejections under 35 USC 112 First paragraph in response to the remarks and amendment filed on December 17, 2007, and rejected all the claims over art.

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February 20, 2009 Pre-Appeal Brief request filed.

May 13, 2009 Decision to proceed to Board on Pre-appeal brief request mailed.

June 15, 2009 Appeal brief Filed.

September 8, 2009 Notification of Non-Compliant Appeal Brief mailed stating that the Brief did not provide a concise explanation of the subject matter.

October 8, 2009 Appeal Brief filed,

December 31, 2009 Notice of Defective brief mailed stating that the Brief provides citations that support claims with a different scope than the pending claims.

March 01, 2010 Instant Petition under 37 C.F.R. § 1.181 requesting withdrawal of the Notification of Non-Compliant Appeal Brief filed.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the withdrawal of the Notification of Non-Compliant Appeal Brief mailed on December 31, 2009.

Petitioner is seeking review of the Notification of Non-Compliant Appeal Brief for the reasons set forth below.

Petitioner argues that the Notification of Non-Compliant Appeal Brief, improperly treats as a procedural issue, substantive issues under which applicants are entitled to judicial review.

RULES AND PROCEDURE

37 CFR § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

.....

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

.....

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP § 1201 states, in part:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. **Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).**

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board....

1205.02 [R-3] Appeal Brief Content

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. If appellant does not provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief. See 37 CFR 41.37(d).

1205.03 [R-3] Non-Compliant Appeal Brief and Amended Brief

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner and the Board. The examiner will review the brief to ensure that the required items of the brief are present. Both the Board and the examiner will review the brief for compliance with the content requirements of the brief (37 CFR 41.37(c)). 37 CFR 41.37(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer to file an amended brief. Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The Office may use the form paragraphs set forth below or form PTOL-462, "Notification of Non-Compliant Appeal Brief (37 CFR 41.37)" to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

Under 37 CFR 41.37(d), the appellant may file an amended brief to correct the deficiencies in the original brief. Moreover, **if appellant disagrees with the holding of noncompliance, a petition under 37 CFR 1.181 or 41.3 may be filed.** Filing a petition

will not toll the time period. Appellant must timely reply to the notice or the Office communication that requires an amended brief.

.....
In response to the Notice of Non-Compliant Appeal Brief (37 CFR 41.37) or the Office communication that requires an amended brief, appellant is required to file an amended brief that is either a complete new brief with the required corrections or a replacement section(s).....

(B) When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice.

REQUIREMENTS

A petition under 37 CFR § 1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. In addition § 1.181 (f) sets forth: any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Further, when a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, ...it may be required that there have been a proper request for reconsideration (37 CFR § 1.111) and a repeated action by the Examiner.

The petition filed on March 1, 2010 includes elements (1) and (2) above, as well as a request for reconsideration.

DECISION

Petitioner contends that the same basic enablement issue was withdrawn by examiner in the office action mailed March 20, 2008, when examiner withdrew the enablement rejection under 35 USC 112.

A review of the file record indicates that claim 1 was amended in the response filed on December 17, 2007, to overcome the enablement rejection under 35 USC 112 First paragraph on file at that time. Examiner, in response to this amendment and response, withdrew the rejection under 35 USC 112 First paragraph.

Further, the first Notification of Non-Compliant Appeal Brief mailed on September 8, 2009, held the Brief defective for not being concise in the "Explanation of Subject Matter" section. Appellants timely filed a Supplemental Brief on October 8, 2009, to overcome the deficiencies cited in the first Notification of Non-Compliant Appeal Brief mailed on September 8, 2009. The second Notification of Non-Compliant Appeal Brief holds the Brief non-compliant for the reason that "appellant provides citations that support claims with a different scope than pending claims". It is not clear from this statement, if the Examiner holds that the claims, as currently presented, are not enabled. If the claims, as they exist currently, had enablement issues, the prosecution

history does not provide any evidence that Appellants were appraised of such an issue, before the filing of an appeal.

Per MPEP 1201, Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, **the questions thereby raised are said to relate to the merits**, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).

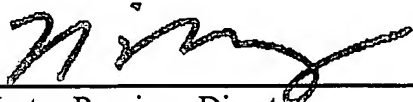
Thus, it is improper under current office practice to make the brief non-compliant for the reasons set forth in the Notification of Non-Compliant Appeal Brief mailed on December 31, 2009.

For the above stated reasons, the petition is **GRANTED**.

The Notification of Non-Compliant Appeal Brief mailed on December 31, 2009, is hereby vacated.

The Application has been forwarded to examiner of record to consider the Appeal Brief filed on 6/15/2009, and the Supplemental brief filed on October 8, 2009, and issue an appropriate Office Action.

Any inquiry concerning this decision should be directed to Mano Padmanabhan whose telephone number is (571) 272-4210.



Nestor Ramirez, Director
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NRR:mp